REMARKS

Claims 11-20 are all the claims pending in the application.

I. The Pending Claims

The Office Action dated June 2, 2003 indicates that claims 11-22 are pending. However, the pending claims are claims 11-20. The error appears to be due to claims 19 and 20 being listed as "new" in the Amendment filed May 13, 2003. Claims 19 and 20 in the Amendment filed May 13, 2003 were not intended to be two new claims, but rather amendments to pending claims 19 and 20.

II. The Rejection Based on Miyamoto and Hioki

Claims 11-20 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the combination of Miyamoto et al (Miyamoto) and Hioki et al (Hioki).

In the paragraph bridging pages 4 and 5 of the Action, the Examiner sets forth the following three specific allegations for his conclusion that Mr. Nakamura's Rule 132 Declaration fails to rebut the alleged prima facie case of obviousness:

(1) Applicants have not compared the claimed material to the closest prior art of record, namely Miyamoto;

(2) the Declaration is not commensurate with the scope of the claimed invention; and

(3) the improvement shown in the Declaration is limited to cyan residual color and sensitivity.

Applicants respectfully submit that the present invention is not anticipated by or obvious over Miyamoto and Hioki and request that the Examiner reconsider and withdraw this rejection in view of the following remarks.

Applicants' respectfully submit that Miyamoto does not teach or disclose the use of two types of dyes, both within the scope of formula (I) together in a silver halide emulsion. Likewise, Hioki does not teach or disclose the use of two types of dyes, both within the scope of formula (I) together in a silver halide emulsion. Moreover, even if the cited references are combined Applicants' invention would not be obtained. Therefore, it is respectfully submitted that the Examiner has not established a *prima facie* case of obviousness in view of the disclosures of Miyamoto and Hioki.

While, as set forth above, it is believed the Examiner has not established a prima facie case of obviousness, to advance the prosecution of the case, Applicants have provided additional declaration evidence showing the improved properties of the presently claimed silver halide photographic emulsion composition over the materials of the references of the rejection. See the attached Declaration Under 37 C.F.R. § 1.132 by Mr. Tetsuo Nakamura.

As to the Examiner's allegation that the evidence of record does not compare the claimed material to the closest prior art of record, Miyamoto, the present §132

Declaration includes comparative experiments using samples from the Examples of Miyamoto.

Further, claim 1 has been amended to recite that the at least two different sensitizing dyes are independently cyanine dyes. Therefore, it is respectfully submitted that the Declaration is commensurate with the claimed invention.

Applicants respectfully traverse the Examiner's conclusion that the types of unexpected improvements shown in the evidence of record are limited to limited to cyan residual color and sensitivity. For example, the Examiner points out that the yellow residual color of comparative sample 307 in Table 4 is found to be less than that of the inventive sample 302. A material need not be better in all respects than prior art compounds. Deutsche Gold-Und Silber-Scheideanstalt Vormals Roessler v. Commissioner of Patents, 148 USPQ 323 (DC DC 1966). Further, in the present invention, the superior result achieved by the invention is an extremely high color sensitivity coupled with lowered residual color. The result is superior even if the residual color is not the absolute lowest, so long as the sensitivity is extremely high and the residual color is relatively low. For example, the residual color of Sample No. 206 in Table 3' is not the absolute lowest (that distinction belongs to the 0.027 value for Sample No. 211), but the combination of an extremely high sensitivity (123) with a relatively low residual color (0.032) is an unexpectedly superior result.

For the above reasons, it is respectfully submitted that the evidence of record shows that the present invention is unexpectedly superior to the materials of the closest art.

For the above reasons, it is respectfully submitted that the subject matter of claims 11-20 is neither taught by nor made obvious from the disclosures of Miyamoto and Hioki and it is requested that the rejection under 35 U.S.C. §103(a) be reconsidered and withdrawn.

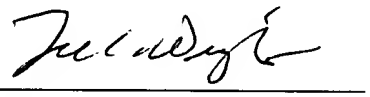
III. Conclusion

In view of the above, Applicants respectfully submit that their claimed invention is allowable and ask that the objection to the claims, the rejection under under 35 U.S.C. §103 be reconsidered and withdrawn. Applicants respectfully submit that this case is in condition for allowance and allowance is respectfully solicited.

If any points remain at issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the local exchange number listed below.

Applicants hereby petition for any extension of time which may be required to maintain the pendency of this case, and any required fee for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,



Lee C. Wright
Registration No. 41,441

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: December 2, 2003